

Appl. No. 10/646,901
Amdt. Dated December 28, 2006
Reply to Office Action of October 31, 2006

REMARKS

This is a full and timely response to the non-final Office action mailed October 31, 2006. Reexamination and reconsideration in view of the following remarks is respectfully solicited.

Claims 1-4, 8-24, and 28-44 remain pending in this application, with Claims 1, 21, 41, and 43 being the independent claims.

Before proceeding to the claim rejections delineated in the Office action, Applicant would like to point out that the Office action, on page 2, states that the rejection of Claim 17 under 35 U.S.C. § 101 does not stand withdrawn. It is believed that this statement was mistakenly included in the Office action, since no rejections of Claim 17, or any other claim for that matter, have ever been made in the instant application. Applicant further wishes to point out that the Examiner, or any one else reviewing the file history of the instant application, should not read too much into Applicant's previous statement that although one of the references may broadly suggest a straight zoom line that extends through a zoom point, and between a central point and a display area edge nowhere does it disclose, or even remotely suggest at least specified features of the independent claims. This statement is clearly not an admission that the noted reference discloses any feature, or combination of features, in the independent claims. It is merely a statement intended to note that the particular reference at least fails to disclose the specified feature.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-40 are now inexplicably rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with both the enablement requirement and the written description requirement. Specifically, the Office action now states, after three years of pendency, various Office actions, responses, and interviews, that the Examiner suddenly fails to understand how the image edge point can remain coincident with the display area edge point during zoom, and that this particular feature was not sufficiently described.

As to enablement, the standard for determining whether the claims in application meet the enablement requirement was set forth by the Supreme Court nearly 100 years

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ago. Specifically, the Supreme Court, in Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916), held that the standard is whether the experimentation needed to practice the invention is undue or unreasonable. Stated another way, “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” United States v. Telecommunications, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The as-filed application does not have to, and preferably does not, teach what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The standard for determining compliance with the written description requirement is an objective one. This objective standard can be generally stated as “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). To satisfy this standard, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date of the application, the Applicant possessed the claimed invention. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Applicant submits that the allegedly non-enabled, insufficiently described features of independent Claims 1 and 21 are disclosed in at least paragraphs [0031]-[0034] and FIGS. 6-10. At least these portions of the as-filed application fully describe and enable the invention encompassed by independent Claims 1 and 21, and the associated dependent claims thereof. Applicant submits that any person of ordinary skill in the art, upon reading at least these sections, could make and use the claimed invention with very little, if any, experimentation, let alone with undue experimentation. Applicant further submits that at least these sections clearly and unambiguously show a person of ordinary skill that the Applicant possessed the claimed invention at the time of the filing of the patent application.

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The Examiner seems to think that because the term "coincident with" was used only twice in selected ones of the as-filed claims, this feature is somehow neither enabled nor described. Applicant wishes to point out that 37 C.F.R. § 1.75(d)(1) states that "the terms and phrases used in the claims must find clear support or antecedent basis in the description *so that the meaning of the terms in the claims may be ascertainable* by reference to the description." See 37 C.F.R. § 1.75(d)(1) (emphasis added). Moreover, M.P.E.P. 608.01(o) states that "[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, *designating the part or parts therein to which the term applies.*" See M.P.E.P. 608.01(o) (emphasis added). These rules and guidelines do not require that each and every claim term be used in a verbatim sense in the specification, or that each term has to have a specific reference numeral in the drawings. Rather, Applicant submits that the intent of Rule 75 and M.P.E.P. § 608.01(o) is that the description be written so that terms used in the claims are *readily ascertainable*.

Here, paragraph [0031], lines 7-12 of the as-filed application states, "the displayed image 204 includes an image edge point 508 that coincides with the display area edge point 506. As will be clarified further below, this image edge point 508 is 'bound' to the display area edge point 506 when the relative size of the image 204 is being changed. In other words, when the relative size of the image 204 is being changed, the position of the image point 508 that corresponds with the edge point 506 will be maintained." At least this portion of the as-filed application provides support for the image edge point remaining coincident with the display area edge point.

In addition, the Examiner, cites various alleged mathematical definitions of coincident lines and points, and then states, for some unknown reason, that if the points are coincident the points cannot change, which means no translation can take place. Of course, this is exactly what the description and claims fully describe and enable. More specifically, independent Claims 1 and 21 each state that the image edge point remains coincident with the display area edge point. As described in paragraphs [0031]-[0034],

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the image edge point and display area edge points in fact do not translate, although various points around the image edge point, that make up the image, do translate during the zoom. Thus, as noted above, at least paragraph [0031] states that the image edge point is "bound" to the display area edge point when the relative size of the image is being changed.

In view of the foregoing, Applicant submits that Claims 1-40 are fully enabled and described, and respectfully request reconsideration and withdrawal of the § 112, first paragraph rejections.

Rejections Under 35 U.S.C. § 103

Claims 1-3, 21-23, and 41-44 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,407,749 (Duke et al.) and U.S. Patent Application Publication No. 2004/0233222 (Lee et al.), Claims 2, 9, 11-19, 22, 29, and 32-39 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Duke et al., Lee et al., and U.S. Patent No. 6,396,507 (Kaizuka et al.), Claims 20 and 40 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Duke et al., Lee et al., Kaizuka et al., and U.S. Patent No. 6,333,996 (Kato), Claims 4, 8, 24, and 28 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Duke et al., Lee et al., and U.S. Patent Application Publication No. 2002/0149605 (Grossman et al.), and Claims 10 and 30 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Duke et al., Kaizuka et al., and U.S. Patent Nos. 5,583,984 (Conrad et al.). These rejections are respectfully traversed.

Independent Claims 1 and 21 recite that, while zooming, the position of the image edge point is maintained such that the image edge point remains coincident with the display area edge point, and independent Claims 41 and 43 each recite maintaining an alignment of the image points with the display area edge that includes the display area edge point to which the zoom line extends.

While not conceding that Duke et al. discloses any of the features that the Office action alleges, Applicant submits that this reference fails to disclose, or even remotely suggest, at least the above noted features of independent Claims 1, 21, 41, or 43. Namely,

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Duke et al. fails to disclose or suggest at least that the image edge point remains coincident with the display area edge point, and/or maintaining an alignment of the image points with the display area edge that includes the display area edge point to which the zoom line extends. Indeed, the Office action avers to at least this fact, but cites Lee et al. as allegedly suggesting this feature.

Lee et al. relates to a system and method for controlling 3-D computer model scaling. The Office action alleges that paragraphs [0085]-[0089] and FIGS. 9 and 10 disclose the above-noted features of the independent claims. However, as even the Office action points out, all that these portions of Lee et al. disclose is that the position of the model zoom point (901) translates along a line (920) to an optimum viewing point (903) during a zooming operation. Nowhere does this portion of Lee et al., or any other portion for that matter, disclose or even remotely suggest that an image edge point remains coincident with a display area edge point, and/or maintaining an alignment of image points with a display area edge that includes the display area edge point to which a zoom line extends.

All of the other applied references have been thoroughly reviewed and none is understood to make up for at least the above-noted deficiencies of independent Claims 1, 21, 41, and 43. As such, none of the claims that depend from these independent claims is believed to be rendered obvious.

Applicant also wishes to point out that the Examiner, in both the most recent Office action and in previous Office actions, makes what Applicant believes is both an incoherent and irrelevant argument regarding the mathematical formula for a straight line. Most troubling about the line of argument is that the Examiner alleges that Applicant is attempting to patent a fundamental law of geometry, and appears to opine that the recitation in the claims that the selected zoom point translates along a straight zoom line that passes through the selected zoom point and extends between a central point in the display area and the display area edge point is, to use his words, "beside the point." See Office action at 9. In making this argument the Examiner focuses on one statement in a claim, and completely ignores the mandate that the claim must be read in its entirety. Applicant is not attempting to patent any fundamental law. Although certain features of

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the invention, as with any other patentable invention, do rely on fundamental mathematical and physical laws, it is the application of these laws to a new and useful invention that is being patented.

In view of the foregoing, Applicant requests reconsideration and withdrawal of the § 103 rejections. Moreover, because this application has been pending as long as it has, Applicant further requests that the Examiner, if he decides to not allow the pending claims, inform the undersigned expeditiously so the he may quickly move ahead with an appeal to the Board of Patent Appeals and Interferences.

Conclusion

Based on the above, independent Claims 1, 21, 41, and 43 are patentable over the citations of record. The dependent claims are believed to be patentable for the reasons given above with respect to the independent claims and because each recite features which are patentable in its own right. Individual consideration of the dependent claims is respectfully solicited.

The other art of record is also not understood to disclose or suggest the inventive concept of the present invention as defined by the claims.

Hence, Applicant submits that the present application is in condition for allowance. Favorable reconsideration and withdrawal of the objections and rejections set forth in the above-noted Office action, and an early Notice of Allowance are requested.

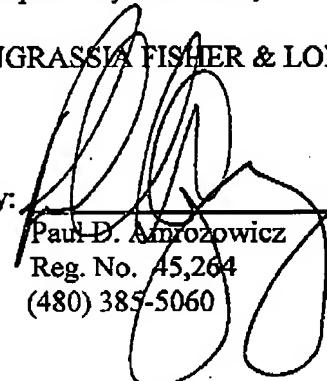
If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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If for some reason Applicant has not paid a sufficient fee for this response, please consider this as authorization to charge Ingrassia, Fisher & Lorenz, Deposit Account No. 50-2091 for any fee which may be due.

Respectfully submitted,

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